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APPLICATION NO.	FILING DATE	FIRST NAMED INVENTOR	ATTORNEY DOCKET NO.	CONFIRMATION NO.
09/841,842	04/25/2001	Mark Stumne	6967.01	5820

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MINNEAPOLIS, MN 55402-1498

EXAMINER
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KRAMER, JAMES A

ART UNIT	PAPER NUMBER
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3627

DATE MAILED: 01/12/2005

Please find below and/or attached an Office communication concerning this application or proceeding.

## Office Action Summary

Application No.

09/841,842

Applicant(s)

STUMNE ET AL.

Examiner

James A. Kramer

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-- The MAILING DATE of this communication appears on the cover sheet with the correspondence address --

### Period for Reply

A SHORTENED STATUTORY PERIOD FOR REPLY IS SET TO EXPIRE 3 MONTH(S) FROM THE MAILING DATE OF THIS COMMUNICATION.

- Extensions of time may be available under the provisions of 37 CFR 1.136(a). In no event, however, may a reply be timely filed after SIX (6) MONTHS from the mailing date of this communication.
- If the period for reply specified above is less than thirty (30) days, a reply within the statutory minimum of thirty (30) days will be considered timely.
- If NO period for reply is specified above, the maximum statutory period will apply and will expire SIX (6) MONTHS from the mailing date of this communication.
- Failure to reply within the set or extended period for reply will, by statute, cause the application to become ABANDONED (35 U.S.C. § 133). Any reply received by the Office later than three months after the mailing date of this communication, even if timely filed, may reduce any earned patent term adjustment. See 37 CFR 1.704(b).

### Status

- 1) ☒ Responsive to communication(s) filed on 29 October 2004.
- 2a) ☐ This action is **FINAL**. 2b) ☒ This action is non-final.
- 3) ☐ Since this application is in condition for allowance except for formal matters, prosecution as to the merits is closed in accordance with the practice under *Ex parte Quayle*, 1935 C.D. 11, 453 O.G. 213.

### Disposition of Claims

- 4) ☒ Claim(s) 1-24 and 27-65 is/are pending in the application.
- 4a) Of the above claim(s) \_\_\_\_\_ is/are withdrawn from consideration.
- 5) ☐ Claim(s) \_\_\_\_\_ is/are allowed.
- 6) ☒ Claim(s) 1-24 and 27-65 is/are rejected.
- 7) ☐ Claim(s) \_\_\_\_\_ is/are objected to.
- 8) ☐ Claim(s) \_\_\_\_\_ are subject to restriction and/or election requirement.

### Application Papers

- 9) ☐ The specification is objected to by the Examiner.
- 10) ☐ The drawing(s) filed on \_\_\_\_\_ is/are: a) ☐ accepted or b) ☐ objected to by the Examiner.  
Applicant may not request that any objection to the drawing(s) be held in abeyance. See 37 CFR 1.85(a).  
Replacement drawing sheet(s) including the correction is required if the drawing(s) is objected to. See 37 CFR 1.121(d).
- 11) ☐ The oath or declaration is objected to by the Examiner. Note the attached Office Action or form PTO-152.

### Priority under 35 U.S.C. § 119

- 12) ☐ Acknowledgment is made of a claim for foreign priority under 35 U.S.C. § 119(a)-(d) or (f).
- a) ☐ All b) ☐ Some \* c) ☐ None of:
1. ☐ Certified copies of the priority documents have been received.
2. ☐ Certified copies of the priority documents have been received in Application No. \_\_\_\_\_.
3. ☐ Copies of the certified copies of the priority documents have been received in this National Stage application from the International Bureau (PCT Rule 17.2(a)).

\* See the attached detailed Office action for a list of the certified copies not received.

### Attachment(s)

- 1) ☐ Notice of References Cited (PTO-892)
- 2) ☐ Notice of Draftsperson's Patent Drawing Review (PTO-948)
- 3) ☐ Information Disclosure Statement(s) (PTO-1449 or PTO/SB/08)  
Paper No(s)/Mail Date \_\_\_\_\_
- 4) ☐ Interview Summary (PTO-413)  
Paper No(s)/Mail Date. \_\_\_\_\_
- 5) ☐ Notice of Informal Patent Application (PTO-152)
- 6) ☐ Other: \_\_\_\_\_

## DETAILED ACTION

### *Claim Rejections - 35 USC § 112*

The following is a quotation of the first paragraph of 35 U.S.C. 112:

The specification shall contain a written description of the invention, and of the manner and process of making and using it, in such full, clear, concise, and exact terms as to enable any person skilled in the art to which it pertains, or with which it is most nearly connected, to make and use the same and shall set forth the best mode contemplated by the inventor of carrying out his invention.

Claims 1-24 and 27-65 rejected under 35 U.S.C. 112, first paragraph, as failing to comply with the enablement requirement. The claim(s) contains subject matter which was not described in the specification in such a way as to enable one skilled in the art to which it pertains, or with which it is most nearly connected, to make and/or use the invention. Specifically, Applicant claims an operator, a customer and a user. Examiner asserts that the specification lacks information about the relationships between these essential parts which one of ordinary skill in the art could not develop without undue experimentation (MPEP 2164.06(a)).

Examiner notes that Applicant's specification refers to how each of these parts interacts with the system and method of the present invention, however fails to describe who these parts are. These relationships seem to be essential to the novelty of the invention.

For example, Applicant defines an "operator" as an equipment operator. Examiner assumes that this means the person who drives a car or truck. Applicant's operator interacts the present invention by submitting incident information to an advisor. The advisor then performs a vendor search by accessing parameters which include customer-related information (specification page 8; line 19 – page 9; line 10). Examiner notes that it is unclear from the specification who the customer is. Applicant fails to describe, define or give examples of who the customer is. Applicant further fails to describe the relationship between the customer and the

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operator. Examiner asserts that one of ordinary skill could not reasonably define that relationship without undue experimentation.

Finally, Examiner notes that the customer must be an essential part as Applicant has amended the claims to include this limitation and further argues this point in the Remarks to Amendment submitted 10/29/04.

The following is a quotation of the second paragraph of 35 U.S.C. 112:

The specification shall conclude with one or more claims particularly pointing out and distinctly claiming the subject matter which the applicant regards as his invention.

Claims 1-24 and 27-65 are rejected under 35 U.S.C. 112, second paragraph, as being indefinite for failing to particularly point out and distinctly claim the subject matter which applicant regards as the invention.

Examiner notes, for the reasons presented above, the claims fail to clearly and distinctly point the subject matter of the present invention. Specifically, as stated above it is unclear the relationship between the Operator, Customer and User.

For the purpose of compact prosecution, the Examiner will consider the operator a vehicle driver/owner, the customer and agent are an insurance agent or American Automobile Association (AAA) agent.

### ***Claim Rejections - 35 USC § 102***

(b) the invention was patented or described in a printed publication in this or a foreign country or in public use or on sale in this country, more than one year prior to the date of application for patent in the United States.

Claims 1-24 and 27-65 are rejected under 35 U.S.C. 102(b) as being anticipated by

Official Notice.

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Examiner takes Official Notice that the emergency roadside assistance is old and well known in the art. In fact the American Automobile Association (AAA) began providing this service in the early 1900's. AAA receives incident information from an operator (a user calls in with a flat tire or in need of a tow). Upon receiving this incident information a AAA advisor searches for a selects a vendor from a database. This searching step is based on the incident information (specifically the type of plan the equipment operator has e.g. towing distance, tire repair, etc) and based on AAA preference information (customer preference information). Examiner notes that AAA has contracts with service stations/vendors. When the search for a vendor they first consider these contracts, which clearly represents cost limit considerations.

Next, AAA contacts a vendor, provides them with the incident information. Upon contacting the vendor a work authorization is generated. The vendor builds invoice information and sends a bill for the services rendered to AAA (the customer).

Examiner notes that Applicant includes some language which states "automatically" performing these various steps. Examiner notes here that broadly providing an automatic means to replace a manual activity which accomplishes the same result is not sufficient to distinguish over the prior art.

### ***Conclusion***

Any inquiry concerning this communication or earlier communications from the examiner should be directed to James A. Kramer whose telephone number is (703) 305-5241. The examiner can normally be reached on Monday - Friday (8AM - 5PM).


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If attempts to reach the examiner by telephone are unsuccessful, the examiner's supervisor, Richard Chilcot can be reached on (703) 305-4716. The fax phone number for the organization where this application or proceeding is assigned is 703-872-9306.

Information regarding the status of an application may be obtained from the Patent Application Information Retrieval (PAIR) system. Status information for published applications may be obtained from either Private PAIR or Public PAIR. Status information for unpublished applications is available through Private PAIR only. For more information about the PAIR system, see <http://pair-direct.uspto.gov>. Should you have questions on access to the Private PAIR system, contact the Electronic Business Center (EBC) at 866-217-9197 (toll-free).

James A. Kramer  
Examiner  
Art Unit 3627

jak

  
Richard Chilcot  
Supervisory Patent Examiner  
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